

### **Remarks**

Applicants have carefully considered the Office Action dated March 31, 2006 and the references cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Claims 3-17, 19 and 20 are currently pending.

Claims 8-12, 17 and 19-20 are allowed.

Claims 3-7 and 13-16 are rejected.

Claims 3-7, and 13-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6792145, Gay, already of record, in view of U.S. Patent No. 5903646, Rackman, already of record, and further in view of U.S. Patent 6,704,772, Ahmed et al, hereinafter Ahmed. Applicants traverse such rejection on the grounds that the Examiner has failed to create a *prima facie* case of obviousness. In accordance with MPEP §2143.03, to establish a *prima facie* case of obviousness 1) the prior art reference (or references when combined) must teach or suggest *all* of the claim limitations; 2) there must be some suggestion or motivation to modify a reference or combine references; and 3) there must be a reasonable expectation of success.

In setting forth the rejection, particularly with regard to claim 3, the Examiner has expressly admitted that Gay does not disclose the program code, program logic or techniques of creating a shadow document from an original document; identifying one of a parent and channel document of the original document; and storing a reference thereto in the shadow document team. Instead, the examiner is relying on Rackman to disclose such teachings, and further stating that it would it have been obvious to one of ordinary skill in the arts to combine the Gay method with Rackman in order to create a redundant archive so that the document could be retrieved in the event of the primary system failing. Similarly, the Examiner has expressly admitted that Gay does not disclose parsing the original document for selected logistical data comprising any of sender, receiver, original size, subject, date, carbon copies of the original document. Here, the examiner is relying on Ahmed, for such disclosure and further stating that it would it have been obvious to one of ordinary skill in the arts to combine the Gay method with Ahmed in order to provide electronic messaging to multiple users.

Such separate combinations of subgroupings of references is improper as examiner must provide some disclosure, teaching, suggestion, or motivation as to why it would it have been obvious to one of ordinary skill in the arts to combine the Gay method, *as modified by Rackman*, with the further teachings of Ahmed in order rendered the claim subject matter obvious. Examiners separate citation of the combined teachings of Gay with Rackman to obviate one sub limitation and Gay with Ahmed to obviate another sub limitation, does not satisfy the requirements for a *prima facie* case of obviousness, most notably that the prior art references when combined must teach or suggest *all* of the claim limitations and there must be some suggestion or motivation to modify a reference or combine references. This is particularly true where the Examiner has already acknowledged that Gay does not disclose creating a shadow document from an original document. Accordingly, applicants respectfully assert that claims 3 and 13, as well as their respective dependent claims, patently distinguished over the combined teachings of Gay, Rackman and Ahmed.

Further, even if a rejection based on the combined teachings of Gay, Rackman and Ahmed, were proper, which applicants are not conceding, applicants respectfully traverse such rejections on the grounds that the prior art references when combined do not teach or suggest *all* of the claim limitations. The Examiner is alleging that the disclosure in Ahmed discloses “parsing” of the original document for logistical data. Applicants respectfully disagree. The section of Ahmed (column 11, lines 50-67) discloses “duplication” of electronic messages, not parsing.

Regarding the rejections of claims 6-7, even if the rejection based on the combined teachings of Gay, Rackman and Ahmed, were proper, which applicants are not conceding, applicants respectfully traverse such rejections on the grounds that the prior art references when combined do not teach or suggest *all* of the claim limitations. Claim 6 specifically recites a method comprising “creating a shadow document from an original document *“upon transmission of an original document to the communication process”* (claim 6, lines 4-5). Claim 7 specifically recites a method comprising “creating a shadow document from an original document *“upon the sending of an original document to the communication process”* (claim 7, lines 4-5). In setting forth the rejections of these claims the examiner has cited only the sections of Gay and Rackman

which have been previously cited on the record to disclose only those limitations imported from claim 1, which, based on the prior rejections of claims 6 and 7, the examiner has impliedly admitted are not taught, disclosed or suggested by Gay or Rackman, whether considered singularly or in combinations. If the examiner is relying on Ahmed to disclose such subject matter, then the rejections are improper as the Examiner has not provided any disclosure, teaching, suggestion, motivation as to why it would it have been obvious to one of ordinary skill in the arts to combine the Gay method, *as modified by Rackman*, with the further teachings of Ahmed in order rendered the subject matter of claims 6-7 obvious. Accordingly, applicants respectfully assert that claims 6-7 are patentable in their respective current forms.

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he is invited to call Applicants' attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. DA-12-2158.

Respectfully submitted,

/Bruce D. Jobse/

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